Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOKO YAMADA and SHINJI ITOH

Appeal No. 2001-2697
Application No. 08/770,048

HEARD: September 19, 2002

Before BARRETT, DIXON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2, 3, and 5, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method of producing a composite image. An understanding of the invention can be derived from a reading of exemplary claim 2, which is reproduced as follows:

2. A method of reproducing a composite image, comprising the steps of:

photoelectrically reading out an image recorded on an original medium at a rough picture element interval to obtain a rough image signal representing the image;

processing the rough image signal using initial signal composing conditions to produce a rough composite image signal;

displaying the rough composite image signal as a visible image;

correcting the initial signal composing conditions and the visible image so that the visible image satisfies a desired image composition, wherein the desired image composition includes type of text, position of text, margin information, composite image size information, composite image orientation information;

photoelectrically reading out the image recorded on the original medium at a fine picture element interval to obtain a fine image signal representing the image;

processing the fine image signal using the corrected signal composing conditions to produce a fine composite image signal;

reproducing the fine composite image signal as the composite image on a photosensitive material.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McDonald	5,272,549	Dec. 21, 1993
Zelten	5,652,663	Jul. 29, 1997

Claims 2, 3, and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over McDonald in view of Zelten and well known prior art.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 20, mailed April 10, 2001) for the examiner's complete reasoning in support of the rejection, and to appellants' brief (Paper No. 18, filed January 29, 2001) and reply brief (Paper No. 22, filed June 11, 2001) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 2, 3, and 5. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We begin with independent claim 2. The examiner's position (answer, page 5) is that "McDonald does not specifically teach separately scanning the same original document at the different resolutions for image composition on the display." To overcome this deficiency in McDonald, the examiner turns to Zelten and well known prior art. The examiner asserts (answer, page 6) that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine McDonald and Zelten such that both low resolution image and high resolution image are generated by scanning the document a plurality times, a prescan before the image composing and a final scan after the image composing." The examiner's motivation (id.) is that "during

generation of the image composing conditions, the memory space required to store the image data is reduced since the image is at low resolution, freeing more space of the memory for storing other data." The examiner further asserts (answer, page 8) that because McDonald discloses using a low resolution image for displaying and composition correction, and Zelten disclosed a low resolution image for displaying and image enhancing, that this is motivation to combine the teachings of McDonald and Zelten. The examiner additionally asserts (answer, page 6) that neither McDonald nor Zelten explicitly discloses that the desired image composition includes types of text, margin information, composition size information, and composition image information. The examiner takes Official notice that these image composition features are well known in the art. The examiner asserts (answer, page 7) that because McDonald discloses that any number of software applications for desktop publishing can be utilized in composing the composite image, that it would have been obvious to include the desired image composition in McDonald and Zelten.

Appellants assert (brief, pages 11-14) that the examiner has failed to establish motivation for combining McDonald and Zelten. Appellants argue that the examiner is using hindsight and has not pointed to any portions of McDonald or Zelten that would direct

one of ordinary skill in the art to achieve a method of reproducing a composite image as recited in claim 2. Specifically, appellants assert (brief, page 13) that McDonald teaches scanning the image once at high resolution and subsequently converting the image to a lower resolution for editing in order to speed the transmission and editing process. It is further argued (id.) that Zelten does not have any teachings regarding the incorporation of features into a scanned image such as text, margins, etc. Appellants further argue (brief, page 14) that the image editing and reproduction techniques of McDonald and Zelten are mutually exclusive and that "[a]dditionally, since McDonald initially scans the image at a high resolution suitable for final processing and is able to convert it to a lower resolution for processing and editing, there is no motivation to perform a first lower resolution scan and a second higher resolution scan for image processing and reproduction."

With respect to the examiner's assertion (answer, page 6) that the motivation to combine McDonald and Zelten is to free memory space for storing other data, appellants (reply brief, pages 3-5) argue to the effect that neither McDonald nor Zelten provide any teachings regarding freeing memory because Zelten

discloses that the low resolution image is used to allow the scanner to operate at high speed and reduce wait time for the user, and McDonald uses low resolution editing to speed transmission and editing time.

Of note is the examiner's statement (answer, pages 8 and 9) that one of ordinary skill in the art would have realized the advantages of having more available memory space "in a case [sic] memory space is a critical factor." We make reference to the answer for a complete statement of the examiner's position.

From our review of McDonald and Zelten, we find no teaching or suggestion to support the examiner's asserted motivation to combine the references so as to free more space of the memory for storing other data. The examiner's statement that an artisan would have realized the advantage of freeing more memory space in the case that memory space is a critical factor is unsupported by evidence because the examiner has not established that freeing up memory space for other uses is a factor, much less a critical factor. The examiner has not pointed to any showing in McDonald or Zelten that would suggest that freeing up more memory space for storing other data is an issue recognized in either reference.

We turn next to the examiner's assertion that McDonald's disclosure of using a low resolution image for displaying and composition correction, and Zelten's disclosure of using a low resolution image for displaying and image enhancing, is motivation to combine the teachings of McDonald and Zelten. We agree with the examiner that both McDonald and Zelten use a low resolution image during an editing process. However, we find that McDonald is directed to integrating edited text material with given color images (col. 2, lines 33 and 34). Once the color image or images are stored in the copy center's telecommunications processor (XTP), the customer generates on his computer the text material to be incorporated with the color image (col. 3, lines 26-30), as a page layout of a document to be printed (col. 3, lines 37 and 38). In contrast, Zelten is directed to a scanner where the user changes color density, tone scale, sharpness, as well as hue and saturation adjustments (col. 4, lines 3-11). After processing the final scan of the corrected image, the user can include the image in an electronic document (col.7, lines 12 and 13). Because McDonald is directed to creating a page layout of a document and Zelten is directed to a scanner which corrects an image that may then be used in an electronic document, we find that if the teachings of McDonald and Zelten were combined in a manner as suggested by the

references, that after the image of Zelten was corrected, the corrected image would be used as the customer's input image in McDonald which is scanned in and then stored in the XTP of McDonald. This modification, along with the factual evidence of the Official notice taken by the examiner would not result in the claimed invention because as taught by McDonald, the original image stored in the XTP is used in creation of the final page layout. Since the XTP image has already been scanned at high resolution, there is no reason why an artisan would be motivated to rescan the same image at the same resolution and resave the same image in the XTP because the high resolution image used in the final page layout is already in the XTP.

In addition, we recognize that Zelten is closer to the claimed invention than is McDonald because Zelten photoelectrically reads on claim 2 with the exception of the image composition including type of text, position of text, margin information, composite image size information, and composite image orientation information[1]. Zelten lacks the desired image composition types because Zelten discloses correcting color density, tone scale, inter-color hue, color saturation, and sharpness (col. 3, line 60 through col. 4, line

[1] At the Oral Hearing, counsel for appellants clarified, in response to a question from the Board, that claim 2 requires each of the listed types of image composition.

11). Because the teachings of McDonald and the facts established by the taking of Official notice relate to page layouts for a document using desktop publishing software, we find that the desk top publishing composition types do not clearly suggest adding the composition types to the image of Zelten. We see no suggestion, and no convincing line of reasoning has been provided by the examiner, that would have suggested to an artisan, the adding of composition types for a page layout of a document, to the scanner of Zelten for application of the composition types on the image in the scanner.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claim 2. Accordingly, the rejection of claim 2, and claims 3 and 5, dependent therefrom, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3, and 5 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

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